

Atty Docket No.: 10013014-1

Remarks

This communication is responsive to the Office Action of December 4, 2007. Reexamination and reconsideration of claims 1-11 & 20-23 is respectfully requested.

Summary of The Office Action

Claims 9-10 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 21-23 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 6 and 11 were rejected under 35 U.S.C. §102(e) as being anticipated by AAPA (Applicant Admitted Prior Art, referencing US Pub. 2003/0097469).

Claims 1, 4, and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA (Applicant Admitted Prior Art, referencing US Publication 2003/0097469).

Claims 20-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA (Applicant Admitted Prior Art) in view of "Official Notice".

Claims 2, 3, and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Basso et al. (US Patent No. 6,370,119).

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Basso et al. and in further view of "Official Notice".

Atty Docket No.: 10013014-1

Claim Language

The Office Action on page 3, section 2, indicates that claims 1 and 6 include "intended use" language, which does not add any patentable weight. Applicant respectfully disagrees and requests that specific authority be cited to support such a position. The language in question adds specific features to the claims relating to how the method operates. The language must be considered and given weight, not ignored.

MPEP 2143.03 specifically instructs examiners to consider every word in a claim:

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

MPEP 2143.03 goes even further to explain the importance of every word in a claim, and states, "A claim limitation which is considered indefinite cannot be disregarded" and "... all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed..." Therefore, the selected claim language cannot be ignore.

I. Claims 21-23 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 21-23 were rejected under MPEP 2164.08(a) for being a single means claim. However, these claims are dependent upon independent claim 20. Therefore, the elements of claim 20 are combined with the elements of its dependent claims when determining the scope of a dependent claim. Thus, the dependent claims 21-23 are not a single means claim as defined by MPEP 2164.08(a). The rejection does not apply and should be withdrawn.

Atty Docket No.: 10013014-1

II. Claims 6 and 11 were rejected under 35 U.S.C. §102(e) as being anticipated by AAPA (Applicant Admitted Prior Art, referencing US Pub. 2003/0097469).

For a 35 U.S.C. §102 reference to anticipate a claim, the reference must teach each and every element of the claim. Section 2131 of the MPEP recites:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent Claim 6

Claim 6 recites a method of gathering diagnostic data by a central processing unit. The method includes:

determining which of the plurality of intermediate collectors are capable of communicating with one or more of the plurality of printing devices to obtain a communication map to allow an automatic intermediate collector failover to occur if an intermediate collector fails to operate

The Office Action cites the specification paragraphs [0003] and [0004] as teaching these elements. However, the cited text fails to anticipate each and every element. Paragraph [0003] explains that "Importantly, the mapping is merely a manual process performed by an operator..." and that when a device fails, "the central controller cannot redirect a remaining one of the other data collection devices to gather the status data from the devices associated with the failed data collection device." (specification, paragraph [0007]). Thus, paragraph [0003] fails to teach "to obtain a communication map to allow an automatic intermediate collector failover to occur if an intermediate collector fails to operate." The claim is not anticipated.

Atty Docket No.: 10013014-1

Claim 6 further recites

transmitting a request signal from the central processing unit to the available intermediate collector requesting the diagnostic data for the identified printing device;

The Office Action cites paragraph [0005] as teaching these features (Office Action, page 4). However as further described in paragraph [0007], "...because the central controller does not actually control the data collection devices, the operators of the data collection devices must manually execute the program to gather the desired data." Thus the CPU does not transmit a request signal to request the diagnostic data as claimed and this feature is not taught.

A prima facie anticipation rejection has not been established and the rejection should be withdrawn. Accordingly, independent claim 6 and dependent claims 7-11 patentably distinguish over the references of record and should now be allowed.

III. Claims 1, 4, and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA (Applicant Admitted Prior Art, referencing US Publication 2003/0097469).

Independent Claim 1

Claim 1 recites a method for configuring data communication paths and includes:

transmitting signals indicative of the communication capabilities to the central controller; and

mapping respective communication paths between the central controller and the printing devices via the one or more appliances as a function of the communication capabilities to obtain an automatic appliance failover to allow diagnostic data to be collected from a selected printing device by way of multiple appliances.

Atty Docket No.: 10013014-1

The Office Action cites paragraph [0003] as teaching the "transmitting" element and cites [0004] as teaching the "mapping" element. Applicant notes that the claimed "mapping" is performed based on the signals transmitted to the central controller in the "transmitting" element. Quite differently, paragraph [0003] teaches an operator manually performs a mapping process for devices that can communicate to each other based on assumptions such as the device addresses (see [0003]). Therefore, signals indicative of the communication capabilities are not transmitted to a central controller and the central controller does not map communication paths "as a function of the communication capabilities" as recited in claim 1. Therefore [0003] describes a different process and fails to anticipate claim 1.

A prima facie anticipation rejection has not been established and the rejection should be withdrawn. Accordingly, Independent claim 1 and dependent claims 2-5 patentably distinguish over the references of record and should now be allowed.

IV. Claims 20-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA (Applicant Admitted Prior Art) in view of "Official Notice".

Independent Claim 20

Claim 20 recites a system that comprises:

a controller remote from the appliances configured to communicate with the plurality of appliances and being configured to generate a map of the communication paths between the printing devices and the appliances based on signals received from the plurality of appliances;

The Office Action cites paragraphs [0003] – [0004] as teaching these elements. However as previously explained, [0003] teaches that "...the mapping is

Atty Docket No.: 10013014-1

merely a manual process performed by an operator..." and that the "mapping is transmitted to the central controller." (see [0003]). Thus the central controller in [0003] does not generate a map. Therefore, the claimed controller configured to generate a map of the communication paths based on signal received from the plurality of appliances is not taught and the claim is not anticipated.

It then follows that the references fail to teach or suggest that the controller is configured to perform an automatic appliance failover to a second appliance using the map of the communication paths as recited in the claim. Using "Official Notice" fails to cure the previous deficiency and still fails to teach or suggest each and every element of the claim.

Thus a prima facie obviousness rejection has not been established and the rejection should be withdrawn. Accordingly, independent claim 20 and dependent claims 21-23 patentably distinguish over the references of record and should now be allowed.

MPEP §2144.03 speaks directly to "Official Notice". This section counsels that only "in limited circumstances is it appropriate for an examiner to take official notice of facts not in the record or to rely on 'common knowledge' in making a rejection." MPEP §2144.03 This section specifically warns that "such rejections should be judiciously applied." MPEP §2144.03 Applying "Official Notice" to reject the present claims is not "judiciously applying" this technique. For this additional reason these obviousness rejections are improper and should be removed.

V. Claims 2, 3, 7, 8 were rejected under 35 U.S.C. §§103(a) as being unpatentable over AAPA in view of Basso et al. (US Patent No. 6,370,119).

This rejection involves dependent claims. Since the independent claims have been shown to not be taught or suggested by AAPA, then their dependent

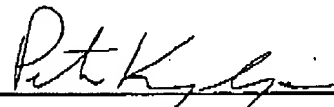
Atty Docket No.: 10013014-1

claims are also not taught or suggested. AAPA fails to establish a prima facie rejection and thus the rejection is improper. The rejection should be withdrawn and all claims allowed.

Conclusion

For the reasons set forth above, claims 1-11 and 20-23 are now in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,



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